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In re Reissue Application of Patent No. 6,010,174
Original Patent Issued: January 4, 2000
Reissue Application No. 10/037,280
Filed: January 4, 2002
Attorney Docket No. 6835

OFFICE OF PETITIONS
ON PETITION

This decision concerns the February 24, 2003 "Petition under 37 CFR 1.47(a)" which, in essence, requests that a supplemental reissue declaration not signed by one of the joint-inventors be accepted. The petition is being properly treated as a petition under 37 CFR 1.183.¹

The petition is **GRANTED**.

Background:

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The chronology of events pertinent to the instant petition is summarized below:

- 1/4/02: Original, **unexecuted**, reissue declaration filed;
- 3/15/02: "Notice to File Missing Parts of Reissue Application" mailed, giving Applicants an extendable 2-month period for submitting an executed oath/declaration;
- 4/12/02: "Reissue Application Declaration and Power of Attorney by Named Inventors" (**first supplemental reissue declaration**), **executed by all 3 inventors**, filed;²
- 10/17/02: Non-final Office action mailed, indicating, *inter alia*, that the 1/4/02 declaration (and thus also the 4/12/02 declaration) was **defective** because it lacked certain components of a reissue oath/declaration as required by

¹ MPEP section 1414.01 (Rev.1, Feb. 2003): "If a joint inventor refuses or cannot be found or reached to sign a supplemental oath/declaration, a supplemental oath/declaration listing all the inventors, and signed by the available inventors, may be filed provided it is accompanied by a petition under 37 CFR 1.183 . . . requesting waiver of the signature requirement of the nonsigning inventor."

² Except for the signatures, the contents are identical to the 1/4/02 declaration.

37 CFR 1.63(a)(4)³ and 1.175(a)(2);⁴ and, setting forth a 3-month shortened statutory reply period;

2/24/03: The instant petition filed along with a 1-month extension of time and the requisite extension-of-time fee.

Analysis:

Three inventors are named in the application: Jay A. Murdock ("Murdock"), Edward G. Curtindale ("Curtindale"), and Ryan E. Dillingham ("Dillingham"). Consequently, a supplemental oath/declaration for this application must be signed by all three since the defects in the 1/4/02 declaration⁵ apply to all of them.⁶

Accompanied by a "Reissue Application Declaration and Power of Attorney by Named Inventors" that has cured the defects noted in the Office action but is signed by only Murdock and Curtindale ("**second supplemental reissue declaration**"), the petition asserts that Dillingham cannot be reached after diligent effort, and requests that the two available inventors be allowed to file this application on behalf of themselves and Dillingham.

In the instant case, Murdock and Curtindale may file the application on behalf of themselves as well as Dillingham, provided that the petition includes Dillingham's last known address; and a statement of facts, signed by a person with firsthand knowledge of the facts cited therein, establishing that a **diligent effort** had been made to locate Dillingham, and that notwithstanding such an effort, Dillingham could not be found.⁷

According to the petition and the accompanying exhibits:

(1) A package mailed to Dillingham at his last known address⁸ on January 8, 2003

³ I.e., that the person making the oath/declaration believes the named inventors to be the first inventors. The Office action incorrectly referenced §1.63(b)(2). The Office action also indicates that the inventors are required by §1.63(a)(4) to state that they are joint inventors. This requirement is not in the current version of 37 CFR.

⁴ I.e., that all errors being corrected in the reissue application up to the filing of the oath/declaration arose without any deceptive intention of the applicant.

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⁵ See *supra* notes 3, 4.

⁶ See MPEP section 1414.01 (Rev. 1, Feb. 2003), quoting *In re Hayes*, 53 U.S.P.Q.2d 1222, 1224 (Comm'r Pat. 1999).

⁷ 37 CFR 1.47(a); MPEP section 409.03(d) INVENTOR CANNOT BE REACHED (Rev. 1, Feb. 2003).

⁸ This is ordinarily the nonsigning inventor's last known residence, which may enable the PTO to communicate directly with the inventor as necessary. See 37 CFR 1.47(a); MPEP sections 409.03(e), 605.03 (Rev. 1, Feb. 2003). (Note: Had this petition involved an original reissue declaration, §1.47 would have been directly applicable; but the underlying rationale is the same)

was undeliverable, and was returned to Assignee's counsel, the sender, on January 16, 2003.

- (2) Assignee's counsel tried to contact Dillingham through his last known telephone number on January 15, 2003, and was informed that another party had acquired that telephone number.
- (3) Assignee's counsel conducted a name search on Internet;⁹ found only 1 name matching that of Dillingham's; called that person on February 6, 2003 and left a message regarding the purpose of the telephone call; but, as of February 18, 2003 when the petition was signed and mailed, did not receive any response.

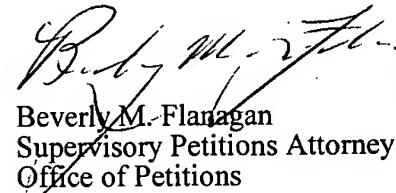
In view of the above, the Office concludes that a reasonably diligent effort had been made by Assignee's counsel to locate or reach Dillingham, and that the latter could not be located or reached despite such an effort. The petition is thus granted.

The second supplemental reissue declaration submitted with the instant petition is hereby accepted.¹⁰

Finally, the Office acknowledges receipt with the petition of the \$130 petition fee, an amendment in response to the October 17, 2002 non-final Office Action, and a Supplemental Information Disclosure Statement.

The application file is being returned to Technology Center 3600 for further examination.

Telephone inquiries should be directed to Petitions Attorney RC Tang at (703) 308-0763.


Beverly M. Flanagan
Supervisory Petitions Attorney
Office of Petitions

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⁹ www.switchboard.com; www.whitepages.com.

¹⁰ The \$130 surcharge for failure to submit an acceptable oath/declaration upon filing of the application was previously remitted on 4/12/02 with the 1st supplemental reissue declaration.